

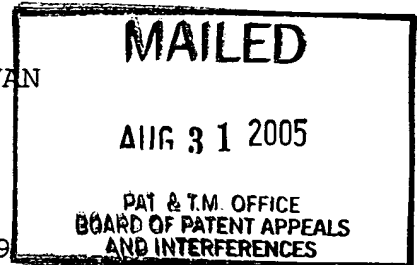
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUNDARAM RAMAKESAVAN

Appeal No. 2005-2401
Application No. 09/234,559



ON BRIEF

Before THOMAS, KRASS, and GROSS, Administrative Patent Judges.
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from twice-rejected claims 1-26.

The invention is directed to a video-on-demand system. In particular, when a user wishes to pause the play of a video, a controller receives the request to pause and automatically requests a code to enable video play to be resumed at a later time.

Appeal No. 2005-2401
Application No. 09/234,559

Representative independent claim 14 is reproduced as follows:

14. A video distribution method comprising:
storing video for selection by the recipient;
upon request by the recipient, allowing the recipient to
select for viewing a stored video;
playing said video; and
in response to a request to pause the play of said video,
automatically requesting a code to enable play to be resumed at a
later time.

The examiner relies on the following references:

Dan et al. (Dan)	5,453,779	Sep. 26, 1995
Saward	5,537,473	Jul. 16, 1996

Claims 14 and 16 stand rejected under 35 U.S.C. § 102(b) as
anticipated by Dan.

Claims 15 and 24 stand rejected under 35 U.S.C. § 103 as
unpatentable over Dan.

Claims 1-13, 17-23, 25, and 26 stand rejected under 35 U.S.C.
§ 103 as unpatentable over Dan in view of Saward.

Appeal No. 2005-2401
Application No. 09/234,559

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

At the outset, we note that there is a prior Board decision (Appeal No. 2002-0336, September 10, 2003) regarding the subject matter of the instant case. In that decision, we reversed the examiner because we found that the automatic retrieval of a code to enable video play to be resumed at a later time did not necessarily flow from the teachings of the reference applied in that case. The instant case involves different prior art references applied against the claims.

We turn, first, to the rejection of claims 14 and 16 under 35 U.S.C. § 102(b).

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the

Appeal No. 2005-2401
Application No. 09/234,559

invention without undue experimentation. In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

It is the examiner's position that Dan anticipates claims 14 and 16 for the reasons set forth at page 2 of the Office action of February 17, 2004. In particular, regarding the "automatically requesting a code to enable play..." limitation, the examiner specifically points to column 2, lines 46-49, and the flowchart of Figure 5, of Dan.

Appellant never responds to the rejection under 35 U.S.C. § 102(b), not in the principal brief nor, even after the examiner pointed this lapse out in the answer, in the reply brief.

While this would normally result in an automatic affirmance of the examiner's decision, assuming a prima facie case has been established by the examiner, we will treat all of the claims together, and respond to appellant's singular argument throughout the briefs, since that argument comprises an assertion that the claimed "automatically requesting a code..." is not made obvious (and, presumably, not anticipated) by Dan.

Thus, the outcome of this case will rest on whether "automatically requesting a code..." is disclosed, either explicitly, or inherently, by Dan.

While Dan does not explicitly mention any "code," the examiner contends that Dan "would receive a code...because it is locked in a pause mode and must be activated by the server to unlock it for resumption of play" (answer-pages 8-9).

Since Dan does not explicitly mention any "code," as claimed, in order for the anticipation rejection to stand, this "code" must be inherent in Dan. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) citing Continental Can Co. v. Monsanto Co., 948 F.3d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. Id. at 1269, 20 USPQ2d at 1749

Appeal No. 2005-2401
Application No. 09/234,559

(quoting In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)).

Thus, if there is another way, besides issuing a "code," that Dan could resume the playing of a video after a pause, one would be hard-pressed to contend that the automatic request of a "code," to enable play at a later time as required by the instant claims is inherent in Dan.

Appellant gives one example of an alternative, at page 2 of the reply brief, surmising that Dan could very well maintain the connection, and, when the user chooses to start playback again, the information that has been stored or which is still available, may be provided to the receiver without requiring a code to identify the receiver. We find that this may be a possible alternative and that, therefore, one may not contend that the claimed automatic request for a code is "inherent" or "implicit" in Dan because appellant has shown that the request for such a code must not necessarily follow in Dan.

Accordingly, while there is a possibility that the examiner's assumption of an automatic request for a code in Dan may be correct, we cannot sustain a rejection based on anticipation or

obviousness on mere speculation, or assumption. We must have evidence on which to base an affirmance of such rejections. While the examiner has cited very relevant art and we truly appreciate the examiner's creativity in attempting to establish a suggestion in the prior art for the claimed automatic request of a code, we find that there just is not enough evidence in the cited art for concluding that this specific claim limitation is taught or suggested.

Accordingly, we will not sustain the rejection of claims 14 and 16 under 35 U.S.C. § 102(b).


Moreover, since all of the independent claims contain the limitation of automatically requesting a code to enable play to be resumed at a later time, and we find no suggestion in either Dan or Saward for such a feature, we will also not sustain the rejection of claims 1-13, 15, and 17-26 under 35 U.S.C. § 103.

Appeal No. 2005-2401
Application No. 09/234,559

Accordingly, the examiner's decision is reversed.

REVERSED

JAMES D. THOMAS
Administrative Patent Judge


ERROL A. KRASS
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

Anita Pellman Gross
ANITA PELLMAN GROSS
Administrative Patent Judge

EAK/dal

Appeal No. 2005-2401
Application No. 09/234,559

TIMOTHY N TROP
TROP, PRUNER, HU & MILES
8554 KATY FREEWAY
STE. 100
HOUSTON, TX 77024